

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

VIKING TECHNOLOGIES, LLC }  
VS. } Case No. 2:20-cv-00357-JRG  
ASSURANT, INC., et al } (Lead Case)

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ASURION, LLC, et al } Case No. 2:20-cv-00358-JRG

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CLOVER TECHNOLOGIES GROUP, } Case no. 2:20-cv-00359-JRG  
LLC, et al }

MARKMAN HEARING AND STATUS CONFERENCE  
BEFORE THE HONORABLE RODNEY GILSTRAP  
UNITED STATES DISTRICT JUDGE  
JUNE 15, 2021

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E X H I B I T S

(None were offered)

P R O C E E D I N G S

THE COURT: All right. This is the time set for claim construction. The Court is taking up claim construction concurrently in three consolidated cases. These include case number 2:20CV357 styled Viking Technologies vs. Assurant, Valu Tech, Teleplan and Broadtech, CWork Solutions, Signal, L.P., Signal GP, and MMI-CPR, LLC.

It also includes case number 2:20CV358 which is Viking Technologies vs. Asurion, LLC, and case number 2:20CV359 styled Viking Technologies vs. Clover Technologies, Clover Wireless, Teleplan Holdings, Teleplan Service, and Reconext LLC.

Let me call for announcements on the record. Let me hear first from the plaintiff, Viking Technologies.

MR. EVERINGHAM: Good morning, Your Honor. May it please the Court, Chad Everingham for Viking Technologies. I'm joined today by my co-counsel with the King & Wood Mallesons firm, John Petrusic and Michael DeVincenzo. Running the slides for us today, Mr. Dominic Vitatiano is here. And we're also joined by our client representative, Mr. Kevin Barnett, who's in the gallery, and we're ready to proceed.

THE COURT: All right. Thank you.

Let me hear from the defendants. We will start

1 with the defendants in the 357 case.

2 MR. DEANE: Good morning, Your Honor. Michael  
3 Deane here, along with my colleague Matt Howell from  
4 Alston & Bird representing the Broadtech entities, and  
5 the entities in the 357 case.

6 THE COURT: All right. Other announcements in the  
7 357 case?

8 MR. DEANE: Your Honor, we represent all of the  
9 defendants in the 357 case.

10 THE COURT: All right. Then let me hear  
11 announcements from the defendants in the 358 case.

12 MS. SMITH: Good morning, Your Honor. Melissa  
13 Smith in the 358 case on behalf of Asurion. I am joined  
14 by Mr. Michael Valaik. Mr. Valaik will be addressing the  
15 Court this morning -- Mr. Valaik, if can you stand -- and  
16 his partner, Ms. Katy Rhoades. And we're ready to  
17 proceed, Your Honor.

18 THE COURT: All right. And how about defendant's  
19 announcements in the 359 case.

20 MR. PINKER: Good morning, Your Honor. Eric  
21 Pinker on behalf of the defendants -- all of the  
22 defendants in the 359 case. I'm here with Patrick  
23 Disbennett, my colleague. I'm also here with my client  
24 representative, Mr. Rich Fischer, who is sitting in the  
25 gallery.

1 THE COURT: All right. And Mr. Pinker, just for  
2 my own clarification, does your firm also represent Valu  
3 Tech in the 357 case?

4 MR. PINKER: We represent Valu Tech which is a  
5 party in the 359 case, Your Honor. I'm not appreciating  
6 that there is a Valu Tech entity named in the 357 case.

7 THE COURT: All right. That could be some error  
8 on my part. I just want to make sure everybody is  
9 covered.

10 MR. PINKER: Yes, sir. I represent all of the  
11 defendants in the 359 case. And there has been an  
12 amendment to the complaint which substituted, and added,  
13 and also removed a party. There are six named defendants  
14 in the 359 case.

15 THE COURT: All right. Thank you.

16 MR. PINKER: Thank you, Your Honor.

17 THE COURT: All right. Counsel, let's jump into  
18 the disputed claim language for purposes of today's  
19 Markman hearing. Let's begin with biasing the cutting  
20 device, and biasing the cutting wire from the 953 and the  
21 357 Patents.

22 Let me hear from plaintiffs first.

23 MR. DEVINCENZO: Good morning, Your Honor. Mike  
24 DeVincenzo on behalf of Viking.

25 THE COURT: Good morning.

1 MR. DEVINCENZO: The first term is biasing or  
2 biasing the cutting device/wire. The dispute with  
3 respect to this term is relatively narrow. The parties  
4 agree that biasing a cutting device or a wire means  
5 applying a force to it. The defendants seek to add an  
6 additional requirement that's not in the claims, that  
7 when the force is applied it must hold the wire or  
8 cutting device in a given position. The defendants  
9 additional language is inconsistent with the claims  
10 itself and the specification and it's not supported by  
11 the prosecution history.

12 With respect to the claims -- and since this is  
13 the first term, I'm going to put up Claim 1 and go  
14 through it a little bit because the claim in this case is  
15 pretty clear and readily understandable, especially with  
16 reference to Figure 7. The claim's about a method of  
17 removing a protective glass top surface from a display  
18 unit. There are three layers in the display unit. It  
19 has a glass top, it has -- that's the top layer in the  
20 figure. It has an electronic display portion, that's the  
21 bottom layer, 22. And then there between is an  
22 intermediate layer. And in Figure 7 that's depicted as  
23 24.

24 So what the claim says is, in order to remove that  
25 glass top surface, the first thing you do is you fix the

1 device in a carriage. The second thing you do is you  
2 align a cutting device in a coplanar relationship with  
3 the intermediate layer. Then you bias the cutting device  
4 in the intermediate layer adjacent to the electronic  
5 display portion and away from the glass.

6 And then later -- and this is the last element --  
7 so now you have the device in the carriage, you have the  
8 wire aligned with that inner layer, and then you drive  
9 the wire or the cutting device into that middle layer.

10 THE COURT: I understand, Counsel, visually to me  
11 is like the cheese board with the wire cutting the pieces  
12 of cheese.

13 MR. DEVINCENZO: Yes, to some extent.

14 And Claim 8, dependent claim, it expressly  
15 requires advancing during the biasing -- so in your  
16 example you would be moving the cheese relative to the  
17 wire or the wire relative to the cheese as you're  
18 biasing.

19 Now Figure 7, the Z is not actually in the figure  
20 but the defendants have that in their brief and it's in  
21 the prosecution history. And the reason Z is important  
22 is because that's the way you're biasing. You're pushing  
23 down. And the reason you're pushing down is not to hold  
24 the wire in place, it's so glass shards don't get caught  
25 in the intermediate layer. And that's explained in the



1 specification.

2 So based on the claim itself, especially Claim 8,  
3 we know that biasing does not require holding the wire in  
4 a given position. It's just directly inconsistent with  
5 the claim language. The defendants admit as much. They  
6 agreed -- and this is from page 12 of their brief -- that  
7 the asserted claims require the cutting device to move,  
8 yet they never grapple with the fact that if the cutting  
9 device is required to move during biasing, which is what  
10 they admit, how can the construction of biasing require  
11 to hold the cutting device in a given position. It's  
12 clearly changing positions.

13 Now the claims are not surprisingly consistent  
14 with the specification. Specification teaches movement  
15 during biasing. In their responsive brief -- and on the  
16 slide I have 632 through 36 but there are several  
17 examples in the parties' briefing. Most important, the  
18 defendants themselves, they admit this. They admit  
19 there's movement during biasing according to the  
20 specification. They explain the specification describes  
21 applying force to the cutting device which holds the  
22 cutting device adjacent to the electronic display as it  
23 moves.

24 And now earlier I talked about the purpose of  
25 biasing. And defendants have said, well, the purpose --

1 and this is in their briefing but it's not reflected in  
2 their construction -- is to hold the constant in the Z  
3 position. So although you would be applying a force down  
4 which would suggest that it could move downwards in the Z  
5 position, in the briefing the defendants said well,  
6 movement is allowed and they conceded that. But they  
7 said, but no movement is possible in the Z position and  
8 they argued that's the purpose of biasing, to keep it  
9 steady. We think that's inconsistent with applying a  
10 force downward. By applying a force downward, generally  
11 something would move down. That's why you're applying a  
12 force.

13 But more importantly it's inconsistent with the  
14 specification. The specification teaches the purpose of  
15 biasing is not to hold it in a constant Z position, it's  
16 to keep it as far away from the glass layer as possible,  
17 to prevent encountering snagging of the glass layer. So  
18 as you hold it down it can go around shards of glass. So  
19 if you're pushing it in the middle of the intermediate  
20 layer and there's shards of glass, you apply a force  
21 downward as you're moving forward and it will go around  
22 that. And on the slide is Column 6, lines 10 through 22.  
23 But this purpose of biasing is also discussed in Column  
24 3, lines 50 through 55. And there it says, also  
25 disclosed is a method further including the step of

1       biasing the wire away from the glass to prevent  
2       encountering snagging of the glass layer -- oh, I'm  
3       sorry, to minimize encounters with broken glass. So  
4       that's the point of biasing. It's not to hold it in a  
5       given position.

6               Now defendants argue otherwise based on one  
7       portion of the specification and they rely on Column 3,  
8       55 to 60. And there a particular embodiment of biasing  
9       is disclosed. And it says a method wherein the biasing  
10      steps includes locating wire guide posts in a plane below  
11      that of the electronic display portion so that the wire  
12      is biased against that portion as it enters and exits the  
13      intermediate layer. And in their briefing defendants  
14      argued, well, this means there can be no movement in the  
15      Z direction because as the wire enters and exits the  
16      intermediate layer it's always going to be against a  
17      specific plane of the electronic display portion. Well,  
18      that's only in the embodiment with wire guide posts.  
19      That's what support here, and wire guide posts would keep  
20      the wire in one position with respect to the Z direction.  
21      But the claims at issue don't require wire guide posts,  
22      and biasing itself without wire guide posts is nowhere  
23      described in the specification as requiring no movement  
24      in the Z direction.

25             Turning to the prosecution history. The

1 prosecution history never distinguished prior art based  
2 on the use of biasing such that no movement could be  
3 required or no movement in the Z direction would be  
4 required. Instead, as stated on page 16 of Applicant's  
5 appeal brief from the Examiner's rejection, they said --  
6 and this is with respect to one of the prior art  
7 reference -- there's no disclosure of biasing as required  
8 by the claims, namely, away from the glass. It was the  
9 direction of biasing that was distinguished, not whether  
10 anything had to be held in place.

11 And in that brief, on this page on the slide,  
12 Tajima's references discuss -- when each of the  
13 references discuss the appeal brief, it's always  
14 distinguished for the same reason, the direction of  
15 biasing. It's not about holding a wire in a given  
16 position.

17 So where does the defendant's construction  
18 actually come from. Well, there were dictionary  
19 definitions discussed in the appeal. And the Applicants  
20 told the Examiner, those of ordinary skill in the art  
21 would readily understand the term biasing requires the  
22 application of some force in this mechanical engineering  
23 art, and then there's a colon there. And this is on page  
24 16 of the Applicant's brief. And there are four  
25 dictionaries listed. I think in our brief we

1 inadvertently said five, but there's four. And I'll go  
2 through them on the next slide.

3 And then later after identifying all four  
4 dictionary definitions, the Applicants explain, "thus,  
5 those of ordinary skill in the arts would fully  
6 understand that the term bias and its related words  
7 includes the application of some force." And the reason  
8 that was in issue is explained in the very next sentence.  
9 The Office action, which was being appealed, had stated  
10 that a biasing force which is not currently claimed. So  
11 in the Office action rejection, the Examiner had  
12 reflected this belief that biasing does not require  
13 application of force. So in the appeal brief they said  
14 yes, it requires an application of force, and it requires  
15 a particular application of force away from the glass  
16 because that's how you get around those shards of glass  
17 as you're trying to pop the glass cover.

18 THE COURT: Is it a constant level of biasing  
19 force or does the level of biasing force vary through the  
20 removal process?

21 MR. DEVINCENZO: It doesn't -- it's -- you have to  
22 bias at least once. You don't have to bias the whole  
23 time. So as you're sliding through, you encounter a  
24 piece of glass, you can bias around it. But you don't  
25 have to bias the whole time. That's not required by the

1 claims and that's not required by defendant's  
2 construction either.

3 THE COURT: All right. What else?

4 MR. DEVINCENZO: And then on the Board's decision,  
5 I have the appeal reply brief. They said, Patent  
6 Examiner's use of the term force as a possible synonym is  
7 not inconsistent with the use of the word in this  
8 application. They said, as a possible synonym is not  
9 inconsistent with the use of the word in this  
10 application, but that's Viking's construction. That has  
11 nothing to do with holding it in place, that's saying a  
12 force is a synonym for bias. And that's how the Board  
13 understood it. In the Board's decision, the Applicant  
14 agrees that the term force is a possible synonym for bias  
15 is not inconsistent with the use of the word in this  
16 application.

17 And then later, "given the general agreement  
18 between the Examiner and the Appellant that bias refers  
19 to force, the Examiner's stated definition does not  
20 appear to be a source of material dispute." So they are  
21 saying biasing means force.

22 And now I'm going to turn to the dictionaries.  
23 And before I said there were four dictionaries. And when  
24 the Applicants were explaining to the PTAB that biasing  
25 means application of force, they referred to all four

1 dictionaries. And all four dictionaries indicate that  
2 biasing would refer to a force. You have Dictionary of  
3 Engineering, "the force applied." The Free Dictionary,  
4 "to influence in a particular direction." The Oxford  
5 Dictionary, "show inclination against something." The  
6 Merriam-Webster Dictionary, "apply a slight negative or  
7 positive voltage." And a voltage is a force. So the  
8 Examiner said -- I mean the Applicant said all of these  
9 dictionaries are consistent with our construction.

10 So what do the defendants do? They take the first  
11 dictionary and they say if we cut it off there and  
12 pretend that's the only dictionary and we say a force  
13 applied to a relay to hold it in a given position, and  
14 that's what they use. And then in their briefing they  
15 put in extrinsic evidence and they say the McGraw-Hill  
16 dictionary similarly says bias in the electrical arts  
17 could refer to the force applied to a relay to hold it in  
18 a given position. And we all agree that electrical arts  
19 if you're applying it to a relay -- which is not what the  
20 invention is about -- it could be to hold it in a given  
21 position. But we know that's not the definition here.  
22 We're not talking about relays. We're not talking about  
23 the electrical arts. We're talking about the mechanical  
24 arts. And we're talking about moving the wire as you're  
25 pushing it through the intermediate layer. These

1 dictionaries are simply inapplicable and they can't be  
2 used to contradict the intrinsic evidence.

3 One more. And then lastly, the defendants rely on  
4 two extrinsic patent applications and they say, well,  
5 these define bias as requiring no movement in a  
6 particular direction. Neither of these applications  
7 actually define the word biasing at all. They simply use  
8 it in a manner -- let me slow down. With respect to the  
9 first one, neither of them define what it means to bias.  
10 Instead they use the term bias, and they say the biasing  
11 force in that application will retain objects, will not  
12 allow movement in a particular direction.

13 Well, in those applications that's what's  
14 explained. That's not the definition used here. And  
15 that can't be used to contradict the intrinsic evidence.  
16 If the force is being applied down as a matter of logic  
17 and reason, the wire may move down. That's how the force  
18 works. If you're applying a force downward it may move  
19 down. And there's nothing in the intrinsic evidence that  
20 says otherwise.

21 THE COURT: All right. What else?

22 MR. DEVINCENZO: That's all.

23 THE COURT: Let me hear from the defendants in  
24 response.  
25



1 MR. VALAIK: Your Honor, Mike Valaik.

2 Biasing here was really the crux of the purported  
3 invention. We see that throughout the prosecution  
4 history, and more importantly in the claim language.  
5 When we actually look at Claim 1 -- and I'll show it here  
6 in a minute of the 537 Patent, it's clear that biasing  
7 the cutting device or wire is really at the heart of  
8 this because the rest of it as plaintiff's counsel  
9 detailed, you align the cutting device, you drive a  
10 cutting device, you advance a cutting device. That  
11 really didn't go to the heart of this invention. Indeed,  
12 that cutting with a wire was around in both industrial  
13 applications and other settings as Your Honor alluded to,  
14 such as a cheese wire.

15 Before showing why we believe, Your Honor, to hold  
16 it -- the cutting device wire -- in a given position is  
17 the appropriate construction, I just want to make two  
18 preliminary points. First, it is not our position that  
19 during biasing the cutting wire is stationary. We said  
20 as such in our briefing, and Viking maintains that to  
21 hold it in a given position means the wire is not moving.  
22 And it's interesting, we'll walk through the prosecution  
23 history and we'll see that defendant's construction here  
24 is; one, what plaintiff offered and really what held  
25 throughout prosecution. And no one got confused that

1 when you use the construction, applying a force to the  
2 cutting device/wire in a given position, means biasing  
3 stationary wire can't move. And so here Viking is just  
4 simply mischaracterizing our position.

5 And the second preliminary point before I walk  
6 through the claim specification prosecution history is  
7 simply if we apply plaintiff's construction, simply  
8 applying the force, we believe you're leaving out the  
9 biasing limitation. Because to move a wire you apply a  
10 force, to drive the wire, to cut the wire you have to be  
11 applying a force. And so leaving that alone, we're going  
12 to take the biasing limitation and in some sense we're  
13 conflating it with the rest of the claim.

14 So why is defendant's construction to add "hold it  
15 in a given position" correct. First, looking at Claim 1  
16 we see the entire limitation, biasing the cutting device  
17 in the intermediate layer adjacent the electronic display  
18 portion and away from the glass. And that's important  
19 because immediately we see how biasing is used in the  
20 asserted claims, it's positional. You are biasing the  
21 device, applying that force so you can stay adjacent the  
22 electronic display so you can maintain that position away  
23 from the glass.

24 When we turn to the specification, similarly --  
25 and this is in the 537 Patent, Column 6, lines 10 through

1       21. We see here first the preferred method -- it's  
2       important, I just want to stop for a minute. This is the  
3       preferred method of separating the electronic display,  
4       not the preferred method of biasing. Because the patent  
5       in the specification discloses a number of different  
6       methods for separating the electronic display. But for  
7       purposes of why to hold it in a given position is the  
8       construction here, Your Honor, we see it talks about  
9       biasing the wire blade, maintaining the cutting element  
10      in a coplanar relationship, and so again positional. You  
11      are applying this force so you can hold it in a given  
12      position. It goes on to say keeping it taut and aligning  
13      it carefully to maintain the coplanar relationship.

14             And then finally as we've discussed, this is to  
15      keep it as far away from the glass as possible to prevent  
16      encountering or snagging of the glass layer.

17             THE COURT: Let me ask you this, Counsel. If  
18      requiring a force means movement how does that not  
19      contradict with your hold it in a position?

20             MR. VALAIK: If we take hold it in a given  
21      position as being stationary, it does contradict it  
22      because application of a force doesn't necessarily mean  
23      you have to move. You can apply a force and that -- it's  
24      not enough force to where that object is physically  
25      moving. But if we take it the next step, that

1 application of a force is going to move that wire then if  
2 "hold it in a given position" means stationary, then that  
3 is contradictory. That is confusing. We believe when  
4 you read "hold it in a given position" in the context of  
5 Claim 1, as well as the specification, it's quite clear  
6 that during the biasing step that you're moving. We  
7 agree with plaintiffs on that point and we don't mean to  
8 suggest in our construction with hold it in a given  
9 position it's going nowhere.

10 THE COURT: Does your view of hold it in a given  
11 position preclude the ability of the wire to move in  
12 what's called the Z direction during its travel through  
13 the intermediate layer?

14 MR. VALAIK: No, Your Honor.

15 THE COURT: So you can't drop down to dodge the  
16 shard glass.

17 MR. VALAIK: You can. I was going to cover this,  
18 but I'll cover it now in light of your question, sir.

19 We said on page nine of our brief, the parties  
20 further agree -- this is our second sentence in the  
21 biasing discussion. "The parties further agree the claim  
22 biasing step requires that the forces apply to the  
23 cutting device in the direction along the Z axis as shown  
24 in annotated version of Figure 7 above, that Applicant  
25 submitted to the Board during prosecution."

1           So we agreed there with plaintiff as well that  
2           biasing requires this application of force in the Z axis  
3           direction. And as counsel said, that could create  
4           movement in the Z axis direction. That's fine with us  
5           and it's just another example where we -- they are  
6           mischaracterizing our position. We did say there would  
7           be no movement.

8           THE COURT: Well, if there can be movement and if  
9           there can be movement in the Z position or Z direction,  
10          where is the merit of the value of adding, to hold it in  
11          a given position? Why is that necessary? Why is it  
12          informative? Why does it help the jury instead of  
13          confuse the jury?

14          MR. VALAIK: Because what we'll see both in the  
15          claim language, the specification, and walking through  
16          the prosecution history is that the whole purpose of  
17          biasing here is positional. The whole purpose, the  
18          inventive concept that they say they claim is that if you  
19          encounter a glass shard, what you need to do in this  
20          application of force as you're maintaining it adjacent to  
21          the electronic display or otherwise, you're going to move  
22          that. You're going to apply a force now in the Z axis.  
23          You're going to go just down and around, simply let's go  
24          around an obstacle. And so what helps the jury here is  
25          to understand that with respect to biasing, not simply

1 driving, cutting, application of force, that this is the  
2 critical step that they claim is inventive. And what  
3 it's doing is maintaining or keeping that wire in a  
4 certain position. And if -- if it connotes to the  
5 average person that means stationary, we can offer an  
6 alternative construction that clears that up. But we  
7 believe it's critical here, it's not simply pulling a  
8 wire and applying a force. That standing alone is, you  
9 know, the same thing as driving, or cutting, or any of  
10 those things. Biasing has to mean more, and it has to be  
11 applying that force to the wire for that positional  
12 purpose.

13 THE COURT: Define what you mean by "positional  
14 purpose"?

15 MR. VALAIK: Well, I'll go back right here.  
16 Positional purpose, Your Honor, looking at the spec here,  
17 would be you bias the wire or blade against, adjacent, or  
18 close to the plane adjacent the electronic display.  
19 Defense says, maintaining cutting element in a coplanar  
20 relationship. And we're going to talk about coplanar  
21 relationship today.

22 THE COURT: I assume we will.

23 MR. VALAIK: And so you want to keep that  
24 position. And then keeping it taut, aligning it  
25 carefully to maintain that coplanar relationship. So

1 we're not simply applying a force, we're doing more.  
2 We're applying a force so that we hold that wire in a  
3 given position or maintaining a certain position.

4 THE COURT: Let me ask you this. Is the biasing  
5 direction called out and specified in the claim language?  
6 And if so, how and where?

7 MR. VALAIK: The specific direction is not called  
8 out, Your Honor.

9 THE COURT: Okay. All right. Let me hear the  
10 rest of your argument.

11 MR. VALAIK: Yes, sir.

12 I've turned now to the prosecution history. And  
13 plaintiff's counsel showed the definitions but I think  
14 it's important to stop at the first definition and show  
15 when they included the definition of bias here, the force  
16 applied to a relay to hold it in a given position. One  
17 is what plaintiffs offered. And I think two, it's  
18 important to mention they said right here, those of  
19 ordinary skill in the art readily understand that the  
20 term biasing requires the application of some force. And  
21 here, what is that art? It's the mechanical engineering  
22 art. And the one definition that plaintiffs offered from  
23 a mechanical engineering source is indeed what we offer  
24 as our construction here today, which includes, to hold  
25 it in a given position.

1 THE COURT: Let me interrupt. Let me go back to  
2 my prior question. When you said that the biasing  
3 direction is not called out in the claim, tell me how  
4 that argument squares with the language in Claim 1,  
5 biasing the cutting device in the intermediate layer  
6 adjacent to the electronic display portion and away from  
7 the glass. Doesn't "away from the glass" denote a  
8 direction?

9 MR. VALAIK: Away from -- if you're going to be  
10 biasing the cutting device in the intermediate layer and  
11 you're adjacent the electronic display portion, we  
12 believe biasing there is simply, you're adjacent that  
13 electronic display. Away from the glass is consistent  
14 with the rest of the specification and the claim, you're  
15 just simply as far away from the glass as you can be. It  
16 is -- it does not say explicitly that biasing force is in  
17 the Z axis direction.

18 And one important point here in the specification  
19 also includes you can -- this can be in both directions,  
20 too. And so, you know, once it's adjacent the electronic  
21 display, simply saying "away from the glass" there is  
22 you're as far away from that glass as you can possibly  
23 be. We don't believe that explicitly says in the Z axis  
24 direction. And Figure 7 here is quite important.  
25 Because in Figure 7 of the patent, we just have our X and



1 Y direction. And what they included in prosecution of  
2 Figure 7, they included in that Z axis direction to make  
3 clear to the Examiner who also didn't understand biasing  
4 in the context of these claims, that in fact we're  
5 talking about application of a force in a Z axis  
6 direction. That wasn't clear based on the claim language  
7 alone to the Examiner.

8 THE COURT: All right. Let's continue.

9 MR. VALAIK: Yes, Your Honor.

10 And so I have on the top of the screen here on our  
11 Slide 6, this was the definition for biasing in the  
12 mechanical engineering art that plaintiff offered. And  
13 it's important -- I mean this is what the Examiner  
14 adopted for purposes of the prosecution. He then  
15 applies, you'll see at the bottom, the very definition  
16 that plaintiffs offer here in the mechanical engineering  
17 art. With respect to these other definitions that  
18 plaintiff's counsel discussed, he said looking at these  
19 three others, they are simply our every day understanding  
20 of biasing to influence in a particular, typically unfair  
21 direction. Also, you know, pause to feel or show  
22 inclination of prejudice. And similarly with respect to  
23 the Miriam Webster, to give a settled and often  
24 prejudiced outlook. I mean those are every day  
25 understandings of biasing. And plaintiff is correct,

1 they did advocate the application of force in the  
2 prosecution but they also had, to hold it in a given  
3 position, and that's what the Examiner adopted.

4 And the last slide I have here, Your Honor, is the  
5 actual decision on appeal. It's clear the Examiner also  
6 states that the definition in the online Dictionary of  
7 Engineering is the force applied to a relay to hold it in  
8 a given position. And Viking didn't object to the  
9 application of that definition in prosecution either.

10 And so just to conclude, Your Honor, I put Claim 1  
11 back on the screen. We believe first when you read the  
12 biasing limitation in context of the entire claim it's  
13 clear that you're moving when biasing, and we agree with  
14 plaintiffs in that respect. But then secondly and more  
15 importantly, biasing is positional. It is the  
16 application of force for a reason, to hold that wire in a  
17 certain given position. You can change the force in the  
18 Z axis direction to go ahead and get around glass. But  
19 simply to say, to apply force, is too broad a  
20 construction for this term and it's going to conflate  
21 with driving, advancing, and some of these other terms in  
22 Claim 1.

23 THE COURT: All right. Thank you, Counsel.

24 Let's move on to the next disputed term,  
25 intermediate layer. Plaintiff tells me there's no

1 construction necessary and defendant gives me a lengthy  
2 construction.

3 Let me start with the defendant in this case and  
4 let me hear their explanation of why the proposed  
5 construction is appropriate.

6 MR. DEANE: Good morning, Your Honor. Michael  
7 Deane here.

8 THE COURT: Good morning, Mr. Deane. Go ahead  
9 when you're ready.

10 MR. DEANE: So the intermediate layer term as we  
11 just discussed is present in multiple places in the  
12 claim, including in the biasing step. And what I think  
13 the dispute here is, Your Honor, is that the defendants  
14 believe that the intermediate layer is everything between  
15 the glass and the electronic display, and our  
16 construction of that term attempts to capture that  
17 concept whereas the plaintiff's construction leaves that  
18 issue open. And the defendant's construction tracks the  
19 specification. And we would be perfectly happy, Your  
20 Honor, if you adopted the language right out of the  
21 specification here as well.

22 THE COURT: Are you talking about Column 5, lines  
23 50 to 56?

24 MR. DEANE: Yes, Your Honor. Where it says that  
25 the intermediate layer is bounded by upper and lower

1 interface planes which are adjacent the electronic  
2 portion in the glass layer. We think that that's  
3 defining the boundary of the intermediate layer, the  
4 glass layer and the electronic display layer. And we  
5 think the second part that says the distance between  
6 those planes is the thickness of the layer. And so we  
7 believe that that means everything in between.

8 And so as you can see from the picture at the  
9 bottom of the screen, there may be multiple components  
10 inside of an intermediate layer. So there may be a layer  
11 of adhesive, a polarizer, and another layer of adhesive.  
12 And so we believe that our construction tracks how the  
13 specification describes the intermediate layer where it's  
14 described as a sandwich structure with the buns being the  
15 glass and the electronic display and everything in  
16 between being the intermediate layer.

17 And I think it's important to point out, Your  
18 Honor, we're not arguing that this requires a specific  
19 orientation. The next line in the specification that I  
20 believe the plaintiffs cite in their brief is, you know,  
21 we believe perfectly valid. Upper and lower are terms  
22 that can be interchanged. But, you know, from our  
23 perspective we're not up here to argue that the glass  
24 always has to be the upper layer and the electronic  
25 display always has to be the lower layer. What we're

1 trying to capture is that everything between is the  
2 intermediate layer. And we think that the reason that  
3 this is important, Your Honor, is because again, the  
4 intermediate layer is where the biasing takes place. And  
5 it's important to define where that location is. And we  
6 think that the potential problem is, is that the  
7 plaintiff may try to argue that the intermediate layer is  
8 only a portion of that layer in between. Because it is  
9 possible to insert a wire in, for example, the upper part  
10 of the intermediate layer or the upper adhesive above the  
11 polarizer. And if you're doing that you're not -- if  
12 you're doing that, you're inserting it into an  
13 intermediate layer. And we think that they are going to  
14 then read the rest of the claim to say that they are then  
15 biasing against the polarizer. And since the polarizer  
16 is in the plane that's most adjacent to the electronic  
17 display, that that somehow meets their claim language.  
18 And we think that that's improper and we think that that  
19 doesn't actually -- that is inconsistent with how the  
20 specification describes the intermediate layer as a  
21 whole.

22 And I'm not sure, I think we're actually not that  
23 far apart on this claim term. But the issue is that the  
24 plaintiff's brief doesn't quite get there. They say that  
25 the claims define the intermediate layer and they say the

1 claims define the intermediate layer as a portion of the  
2 display unit between the glass top and the display  
3 portion. But what they are pointing to is the preamble.  
4 And nobody is arguing that the preamble is limiting. And  
5 so what the defendants are trying to do is clarify the  
6 construction of intermediate layer by using how the  
7 specification describes it and defines it instead of as  
8 the preamble, which nobody argues is limiting.

9 So, you know, I guess if the plaintiff wants to  
10 come up and say that they think that the intermediate  
11 layer is everything in between the glass and the  
12 electronic display portion then we would be in agreement.  
13 But as it stands right now, we believe that plaintiff's  
14 nonconstruction leaves the issue unaddressed.

15 THE COURT: And is that because of the polarizer  
16 as well as the adhesive? Is there an open door here to  
17 something else being in that gap between the glass and  
18 the electronic display or is that just an unknown at this  
19 portion?

20 MR. DEANE: We believe it's unknown in the sense  
21 that plaintiffs' construction leaves it unaddressed. And  
22 there are various different products that are being  
23 accused of infringement, each which have different  
24 components in between. And so our attempt is to make  
25 sure that the plaintiff doesn't come in and argue there

1 are, for example, multiple intermediate layers where some  
2 portion of the intermediate layer consists of one  
3 intermediate layer and if the biasing takes place in that  
4 intermediate layer then it meets their claim element. We  
5 believe that the intermediate layer must consist of  
6 everything in between the glass and the electronic  
7 display.

8 THE COURT: And your primary support for that is  
9 the portion of the specification we talked about in  
10 Column 5?

11 MR. DEANE: Yes, Your Honor. We believe that this  
12 portion of the specification tracks the defendant's  
13 definition. But again, to the extent that this is more  
14 clear, we're happy to adopt this language as well. Our  
15 goal was to capture the concept.

16 THE COURT: Let's look at the drawing you've got  
17 on the screen with the glass, for lack of a better term,  
18 on the top here, and the electronic display on the  
19 bottom, then you've got the adhesive with the polarizer  
20 shown with adhesive on either side of the polarizer. As  
21 a practical matter, does this wire dodge the polarizer in  
22 the middle of this intermediate layer and does it slice  
23 through the adhesive either between the glass and the  
24 polarizer or between the polarizer and the electronic  
25 display? Is the polarizer of a consistency that's equal

1 to the adhesive and it doesn't matter? I mean it almost  
2 looks like the polarizer could be an impediment to use of  
3 the wire between the glass and the electronic display to  
4 remove the glass and still allow for the kind of Z  
5 directional movement that we talked about earlier in  
6 dodging shards of glass, et cetera.

7 Do we have some accused products that are -- or  
8 potentially accused products that have something besides  
9 a polarizer or are there two different polarizers with  
10 adhesive between -- I mean do we have a, you know,  
11 wedding cake situation with layer, layer, layer, layer in  
12 this intermediate area? Tell me what your view of those  
13 questions is.

14 MR. DEANE: So, Your Honor, I guess the best way  
15 to describe it is I think -- I think you're correct and  
16 you're on to what we're also on to here, is that the  
17 different products have different components in there,  
18 and we think that the intermediate layer is the way it's  
19 described by the patent, consists of all of those  
20 components. And so there is in some instances going to  
21 be a wedding cake situation in the sense where there's  
22 going to be one polarizer and two different adhesives in  
23 some products, but we're more concerned with the method  
24 of removal because we -- there's a lot of ways to remove  
25 a protective glass cover from a cell phone. And they



1 have -- the way that they've accused it and the way that  
2 they've accused this specific biasing step is to do it in  
3 a plane adjacent to the electronic display. And so we  
4 don't believe that if you have a method where you're  
5 not -- where you're removing the glass cover but not  
6 removing the polarizer and you have to go back later and  
7 remove the polarizer, you're going to be able to achieve  
8 that biasing step as they've claimed it. And so we think  
9 that of the various different methods that you could  
10 potentially remove glass from a cell phone screen that  
11 they've claimed one of these methods. And so we believe  
12 at minimum to achieve their biasing step they are going  
13 to have to bias adjacent the electronic display, you  
14 know, in reference to that figure.

15 THE COURT: Are you aware of any products where  
16 the wire makes more than one pass between the glass and  
17 the electronic display? Again, go back to your art work  
18 here on the screen. Perhaps the wire runs between the  
19 glass and the polarizer and then comes back and on the  
20 second pass runs between the polarizer and the  
21 electronic display.

22 MR. DEANE: Yes, Your Honor.

23 THE COURT: I would think some polarizers are  
24 probably of a material that would impede the movement of  
25 the wire, and as a practical matter the density of the

1 polarizer would be considerably different than the  
2 density of the adhesive. And as a practical matter,  
3 people in the art would be trying to say in the adhesive  
4 as they remove this, whether it's all done in one pass  
5 between the electronic display and the polarizer or  
6 whether it's done in two passes where you remove the  
7 glass but leave the polarizer and then come back and have  
8 to do a second pass to remove the polarizer.

9 MR. DEANE: That's correct, Your Honor. We're  
10 aware of the -- of the method that you just described,  
11 which was the two pass method where you remove the glass,  
12 and then once the glass top is removed you then come back  
13 later and you remove the polarizer. The polarizer is  
14 very thin, but at the same time there are machines out  
15 there that are -- that do two passes on the device.

16 THE COURT: All right.

17 What else do you have for me on this, Mr. Deane?

18 MR. DEANE: That's it, Your Honor.

19 THE COURT: Let me hear from the plaintiff in  
20 response.

21 MR. PETRSORIC: Good morning, Your Honor, John  
22 Petrsoric from King & Wood Mallesons for the plaintiff,  
23 Viking Technologies.

24 I think this dispute largely comes down to whether  
25 the claim, including the preamble, defines the term

1 versus whether there's a lexicographical definition in  
2 the specification. Clearly as we've been going through  
3 the biasing step, the issue of the spacial construction  
4 with the intermediate layer being sandwiched in between  
5 the glass top and the electronic display portion, is  
6 critical to the way the claims operate because the  
7 biasing step tells us that the cutting device or wire has  
8 to go away from the glass and adjacent the electronic  
9 display. That would clearly suggest that indeed as the  
10 preamble suggests -- and the specification does suggest  
11 as well that the intermediate layer is immediately  
12 sandwiched in between the glass top and the electronic  
13 display.

14 Mr. Deane just mentioned that the defendants would  
15 be okay with the lexicographical definition from the  
16 specification but that is not a clear -- there was no  
17 clear intent in the specification to initiate or to  
18 select that as a definition. And we do believe the  
19 preamble is limiting. It's not a discussion we've had  
20 with the defendants and I don't think anybody has  
21 specifically proposed it, but if the preamble is not  
22 limiting, the claim is -- sort of loses a bit of sense  
23 because how could you then go away from the glass and  
24 adjacent the electronic display if the intermediate layer  
25 isn't sandwiched in between the glass top and the

1 electronic display.

2 And again, if you go back to the preamble of all  
3 the asserted claims the preambles clearly define that the  
4 display unit has a glass top, electronic display portion,  
5 and the intermediate layer there between. So the  
6 intermediate layer in all these instances and in the  
7 infringement as well, is going to be in between the glass  
8 top and the electronic display portion and that's  
9 consistent with the -- what we're showing in Figure 7,  
10 even as annotated by the Applicants during the  
11 prosecution.

12 The specification clearly states that the cell  
13 phones generally use the sandwich structure. This is not  
14 a definitional statement. Neither is the next set of  
15 statements that defendants rely on for their assertion of  
16 lexicography.

17 THE COURT: Let me stop you there. Let's look at  
18 that highlighted language. And it begins with,  
19 "regardless of the nature of the intermediate layer."  
20 Doesn't that pretty much say this covers everything? I  
21 mean that's a pretty broad introductory phrase there,  
22 "regardless of the nature of the intermediate layer."

23 That doesn't raise any indication to you that that  
24 may be lexicographical?

25 MR. PETRSORIC: I don't believe it does. It does

1 not say this specific invention. And I do believe the  
2 claims are drafted to specifically address the  
3 definitional aspect of it.

4 THE COURT: All right.

5 MR. PETRSORIC: So I think the next -- we clearly  
6 agree that regardless of whether something is in an upper  
7 or lower position based on whether the glass is face down  
8 while the method is being performed or whether the glass  
9 is face up while the method is being performed, we're in  
10 clear agreement that the intermediate layer is bounded by  
11 the electronic display portion and the glass. It comes  
12 right out of the claims, nobody is disputing that.

13 THE COURT: Well, if we're all in agreement that  
14 that's the case that whatever is between the bottom of  
15 the glass and the top of the electronic display is the  
16 intermediate layer, where is the fight?

17 MR. PETRSORIC: That's what I -- I think the fight  
18 may well have been whether the preamble is limiting. And  
19 I think plaintiff concedes that the preamble is indeed  
20 limiting in that the intermediate layer is defined by the  
21 sandwich of the glass on one side and the electronic  
22 display portion on the other.

23 THE COURT: Well, maybe I'm -- maybe I'm missing  
24 something here but if both sides are telling me the  
25 intermediate layer is what lies between the glass and the

1 electronic display, why shouldn't I just adopt that as  
2 the construction rather than leave, as you've suggested  
3 in your briefing, no construction is necessary and leave  
4 the door open to some creative trial lawyer in front of a  
5 jury deciding to tell them that it's something different  
6 or there's some other reality here than the intermediate  
7 layer is between the glass and the electronic display.

8 MR. PETRSORIC: We believe that that's what is  
9 expressly stated in the preamble. And if the preamble is  
10 limiting we wouldn't believe that there would be any  
11 further construction necessary beyond that. That it's  
12 already -- that definition is already expressed in the  
13 claim itself.

14 THE COURT: So it's not about what the definition  
15 is, it's about whether it should be expressly stated by  
16 the Court or should be simply left as it exists through  
17 the limiting preamble?

18 MR. PETRSORIC: Yes. Exactly.

19 THE COURT: So that's what we're fighting over?  
20 How to say the same thing we all agree on?

21 MR. PETRSORIC: It would appear that way, yes,  
22 without adding -- without the exercise of adding excess  
23 words like upper and lower that only would be a potential  
24 source of confusion.

25 THE COURT: Okay. All right. Well then what else

1 do you have for me?

2 MR. PETRSORIC: Again, just a quick recap.

3 The claims specify that the intermediate layer is  
4 the layer between the glass top and the electronic  
5 display portion and it's fairly self evident given we're  
6 in the three-dimensional world here that the intermediate  
7 layer, like the glass top and the display portion itself,  
8 are going to have a length, a width, a thickness, and  
9 it's the -- there's beyond the limitation that's set  
10 forth in the preamble, there is not a necessity for the  
11 Court to do anything further in terms of construction.

12 THE COURT: All right. I think I now understand  
13 your position better. Thank you, Counsel.

14 MR. PETRSORIC: Thank you.

15 THE COURT: Okay. Let's go on to, in the  
16 intermediate layer. Again, the plaintiff is proposing no  
17 construction is necessary, the defendant proposes after  
18 the cutting device/wire enters the intermediate layer.

19 Let me hear from the plaintiff first on this.  
20 I'll save you a few steps.

21 MR. PETRSORIC: Thank you, Your Honor.

22 I think the main dispute in the parties'  
23 construction here is whether this boils down to a spacial  
24 limitation or whether this could be a temporal  
25 limitation. Starting with the claims themselves, we

1 are -- biasing is performed, we know, as an expressed  
2 requirement in the claims, in the intermediate layer  
3 adjacent the electronic display portion and away from the  
4 glass. So we know that biasing, we're applying some  
5 force and the parties agree on there is an application of  
6 some force on the cutting device or the cutting wire in  
7 the intermediate layer to move it away from the glass and  
8 adjacent the electronic display portion.

9 So if we look at Figure 7 again, in thinking of  
10 this is a cross-section with the cutting wire, for  
11 example, while it's in the intermediate layer, the glass  
12 is on top and the electronic display portion is below.  
13 Biasing is -- applies a force to bring the wire towards  
14 the electronic display and away from the glass. Again,  
15 this is the expressed language of the claim. And the  
16 expressed language of the claim is that this has to  
17 happen in the intermediate layer.

18 This was re-enforced in the prosecution history.  
19 For example, the Examiner had stated early on that the  
20 method claims did not limit a bias being induced to the  
21 cutting device until it had entered the intermediate  
22 layer. And the Applicants noted in retort that that's  
23 what -- the expressed language of the claims is such that  
24 the biasing must occur in the intermediate layer. Now  
25 undoubtedly and from a practical perspective the



1 Applicants noted that, well, of course if it's going to  
2 happen in the intermediate layer the cutting wire would  
3 have already had to enter the intermediate layer. The  
4 claims make no sense otherwise. But that's also not a  
5 reason to redraft the claims.

6 And of course from based on the Applicant's  
7 argument that the claim specifically require that the  
8 biasing literally occur in the intermediate layer, the  
9 Examiner was overruled by the PTAB and the claims were  
10 allowed. We believe no construction is necessary because  
11 as the defendants say, this is an otherwise clear claim  
12 limitation in that the distinction as from no  
13 construction necessary versus after the cutting device or  
14 wire enters the intermediate layer is an academic  
15 difference. We don't understand how a clear -- how and  
16 why then a clear claim limitation would need to be  
17 redrafted.

18 THE COURT: Let me hear from the defendants,  
19 please.

20 MR. VALAIK: Your Honor, in the intermediate layer  
21 is probably similar to intermediate layer here in that  
22 there really isn't much of a dispute between plaintiff  
23 and defendants.

24 THE COURT: Well, let me ask you this. I'm  
25 looking at your proposed construction and I'm fast

1 forwarding in my mind a jury box with a jury in it, and  
2 lawyers at the table, a trial taking place. I'm worried  
3 about "enters the intermediate layer." When the wire  
4 touches it has it entered it? If half the wire is inside  
5 the intermediate layer and half the wire is outside, has  
6 it entered it. I mean this looks like to me it's rife  
7 with potential disputes and problems, and of course claim  
8 construction is supposed to limit the number of problems,  
9 not increase them. And I'm looking at entering the  
10 intermediate layer, when do you enter? When have you  
11 entered? When are you in the process of entering but you  
12 haven't completely entered yet? This looks like a  
13 Pandora's box to me. So why is this helpful and why is  
14 it necessary as opposed to simply taking the claim  
15 language as it stands and saying that there's no  
16 construction necessary.

17 MR. VALAIK: For two reasons, Your Honor. Again  
18 looking at the prosecution here -- and this is from the  
19 Applicant in the course of prosecution. They said the  
20 Patent Examiner stated one of ordinary skill in the art  
21 upon reviewing Appellant's entire disclosure would not  
22 come to the conclusion that the method claims limit  
23 inducing the bias to the cutting member until after it  
24 enters the adhesive layer. And so Viking makes  
25 abundantly clear biasing has to take place in the

1 intermediate layer after that wire has entered. And yet  
2 when you look at the entire disclosure here, the  
3 sophisticated Patent Examiner did not come to that  
4 conclusion based on the entire disclosure of that. This  
5 biasing step is limited to being in the intermediate  
6 layer.

7 THE COURT: So as half of the wire passes into the  
8 intermediate layer and half of the wire is still outside  
9 the intermediate layer that portion of the adhesive  
10 that's been separated by that first half of the wire was  
11 not biased; is that right? Because all the wire is not  
12 in the intermediate layer yet.

13 MR. VALAIK: Well, our position I think would be,  
14 Your Honor, that once the wire enters the intermediate  
15 layer, any portion of the wire, then you've entered the  
16 intermediate layer.

17 THE COURT: I'm worried about how we define  
18 enters. And we don't have to define enters unless I  
19 adopt your construction. So give me some comfort that  
20 I'm not creating a problem instead of solving a problem.

21 MR. VALAIK: Well, the other part is if we look at  
22 the specification in the 537 Patent -- and I don't have a  
23 slide on this. But we mentioned this in our papers, and  
24 actually plaintiffs had a slide on this in their  
25 presentation. The specification also discloses at Column

1 3, lines 55 through 60, of biasing prior to entering the  
2 intermediate layer. And so, you know, there's a  
3 disclosure where it's in the spec, Viking clearly says  
4 that's not biasing for purposes of this claim. But if  
5 the Court is worried after the cutting device wire enters  
6 the intermediate layer, you know, we -- we could amend  
7 this to make clear any portion of the wire enters the  
8 intermediate layer. But we believe a construction here  
9 is necessary to prevent some dispute down the road.  
10 Because as the Court has seen, the prosecution was rife  
11 with prior art; Sampica, Tajima, some of these other  
12 references which talked about biasing prior to entering  
13 the intermediate layer. And the whole Patent Appeal  
14 Board decision was based on that prior art is  
15 distinguishable because the biasing had not taken place  
16 in the intermediate layer. So we think a construction is  
17 preventing a potential claim construction dispute in the  
18 form of Daubert or something else down the road.

19 But I understand Your Honor's concern. We don't  
20 want to confuse the jury. And so if we put in there "any  
21 portion of the wire enters the intermediate layer" and  
22 that clears up that confusion, we believe we would be  
23 assisting the jury so that they don't make the same  
24 mistake the Examiner here was told he made based on what  
25 Viking said.

1 THE COURT: Well, just for the purpose of  
2 thoroughly confusing everybody, if biasing is applying  
3 force, how does the wire ever enter the intermediate  
4 layer unless a force has already been applied to it to  
5 get it in the intermediate layer?

6 MR. VALAIK: That's true, Your Honor. That's why  
7 we believe biasing, simply the application of force, is  
8 too broad a construction. Because you can't move that  
9 wire unless you apply a force. Biasing has to mean more  
10 than that. And so I think it is confusing.

11 THE COURT: Well, I'm not sure how -- and I'm not  
12 trying to backtrack, but I'm not sure how applying a  
13 force to the cutting device to hold it in a given  
14 position that you proposed for biasing, I don't know how  
15 that addresses that issue of whether the force is applied  
16 to the wire to move it into the intermediate layer, as  
17 opposed to moving it through the intermediate layer once  
18 it's already there.

19 MR. VALAIK: Well, I believe the rest of the claim  
20 will take care of that in terms of -- if we go back to --  
21 I mean the rest of the claim addresses the biasing, the  
22 cutting device in the intermediate layer. And so we  
23 believe read in context why the application of force to  
24 hold it in a given position -- and we could modify that,  
25 Your Honor. We could modify "to hold it in a given

1 position" to "maintain a certain position" so that we get  
2 away from the hold it language if the hold it language is  
3 somehow going to be understood as being stationary. But  
4 we then believe in context that makes sense. Because  
5 when you look at Claim 1 here, you also have the driving  
6 and advancing which is the application of force as well.  
7 And so we believe that additional "to hold it in a given  
8 position" or we would offer "to maintain a certain  
9 position" that really adds meaning to that biasing  
10 limitation and adds clarity. And it's pretty clear, too,  
11 it's adjacent the electronic display. So we think that  
12 would clear it up.

13 Getting back to in the intermediate layer though,  
14 Your Honor, I don't want to leave that fully. Again, we  
15 would agree if we could put in there, if a portion of the  
16 wire -- after a portion of the wire enters the  
17 intermediate layer would clear that up.

18 THE COURT: Well, I mean looking at the claim  
19 itself which you've got on the screen, the biasing step  
20 occurs before the driving step. And if you're talking  
21 about the driving language of the claim addressing the  
22 issue of the force moving the wire into the intermediate  
23 area, aren't you effectively reordering the claim here?

24 MR. VALAIK: And really, this is I think probably  
25 better if plaintiff responds to that. But I think

1 logically biasing has to take place in the intermediate  
2 layer and driving the cutting device into the  
3 intermediate layer by definition then would have to  
4 precede any biasing. You have to enter the intermediate  
5 layer to bias. And so this being the second limitation,  
6 you know, I think lends itself to that very confusion the  
7 Examiner had. Which the Examiner citing prior art,  
8 Sampica and others, where biasing was taking place prior  
9 to entering the intermediate layer, that's reading these  
10 limitations in sequential order here. Certainly don't  
11 know how plaintiff intends to present their case to the  
12 jury, but I'm sure it's going to be driving first in the  
13 intermediate layer. And biasing can take place at any  
14 point as you are cutting through. As plaintiff's counsel  
15 said, it's just once. And so hypothetically, that could  
16 occur at any point.

17 THE COURT: Well, if you take the claim language  
18 on its face and if you don't go behind what the Examiner  
19 did and didn't understand but we have an adopted -- we  
20 have an allowed claim here, we're fixing it, we're  
21 aligning it, we're biasing, and then we're driving it  
22 into the intermediate layer. So on the face of the claim  
23 the biasing limitation occurs before driving it into the  
24 intermediate layer which tells me there can be biasing  
25 outside of the intermediate layer. But you want me to

1 adopt a construction that limits the biasing to occurring  
2 within the intermediate layer.

3 MR. VALAIK: Yes, Your Honor.

4 THE COURT: So how do you reconcile those facts  
5 for me? I mean are you not asking me to reorder the  
6 claim by giving the definition to this language that  
7 you're asking?

8 MR. VALAIK: Well, I think the plaintiff would  
9 cite law that the steps in the method claim do not have  
10 to proceed in sequential order. We haven't had that  
11 argument. And we, quite frankly, haven't had the  
12 discussion with plaintiff, you know, what is the order by  
13 which these steps take place. The prosecution history  
14 was rife with this very dispute and it was resolved  
15 because plaintiff made clear biasing cannot take place  
16 prior to entering the intermediate layer. They were the  
17 ones then who by definition I think limited Claim 1 here  
18 to that understanding, that interpretation, Your Honor.

19 THE COURT: Okay. Anything further?

20 MR. VALAIK: No, Your Honor.

21 THE COURT: Thank you.

22 Okay. Let's go on to the coplanar terms.  
23 Coplanar aligning a cutting device in a coplanar  
24 relationship. And quite honestly, Counsel, this is where  
25 I anticipated most of your arguments would take place,



1 but we've done a good job working up to this point.  
2 Plaintiffs are telling me coplanar means in the same  
3 plane. And defendants tell me that, but when we get to  
4 coplanar relationship defendants tell me that's  
5 indefinite.

6 Let me hear from plaintiff first, and then I'll  
7 hear argument from defendants second.

8 MR. PETRSORIC: Thank you, Your Honor.

9 With respect to coplanar and aligning in a  
10 coplanar relationship, there's two primary disputes. The  
11 first one is whether the cutting device and the  
12 intermediate layer may share more than one plane, and  
13 that's that why we have "a plane."

14 And the second one is whether aligning in a  
15 coplanar relationship is indefinite. And particularly,  
16 whether a person of skill in the art would understand  
17 that two or three-dimensional objects can be described as  
18 coplanar.

19 And I'm going to address these two disputes  
20 together because they are related. Now again, we start  
21 with the language of the claims. And here first with  
22 respect to biasing, the biasing step does occur after the  
23 driving step so they didn't ask for a limitation that  
24 required the method steps to be performed in the same  
25 order. And if they would have, we would have disputed

1 that. So there's no limitation here requiring the method  
2 steps to be performed in this specific order and there's  
3 no dispute about that as far as we understand.

4 THE COURT: Okay.

5 MR. PETRSORIC: And so what does it mean to align  
6 in a coplanar relationship. First as I said before, we  
7 fix the display unit in a carriage. We expose the  
8 intermediate layer on all sides. The very next step says  
9 you align a cutting device in a coplanar relationship  
10 with the intermediate layer. And Figure 7 which is  
11 annotated with a Z, is shown on the slide. We submit  
12 that just based on Figure 7 and reading the claim  
13 language one would understand with reasonable certainty  
14 what it means to align a wire in a coplanar relationship  
15 with the layer. And the specification does more than  
16 just give Figure 7, it gives example after example of  
17 what it means to be coplanar and what it means to be in a  
18 coplanar relationship. And I'm going to go on to the  
19 specific descriptions in the specification.

20 THE COURT: Well, how do you respond to what I  
21 assume I'm going to hear from the other side that even a  
22 judge without an engineering degree, took ninth grade  
23 geometry, and in ninth geometry coplanar was between two-  
24 dimensional objects, not three-dimensional objects.

25 MR. PETRSORIC: Well, I believe in geometry,

1 perpendicular and parallel are also between two-  
2 dimensional objects and not three-dimensional objects.  
3 So often those of skill in the art of mechanical  
4 engineering understands that these descriptions -- and  
5 it's not just coplanar, it's coplanar relationship. So  
6 it doesn't say the two- or three-dimensional objects are  
7 coplanar, it describes them having a coplanar  
8 relationship. And when looked at in light of the  
9 specification, one skilled in the relevant art which  
10 would not be a geometry professor, at least that's our  
11 understanding, would understand what it means and it says  
12 so right in the patent, and explains it. Column 1, 53 to  
13 59. This is right -- when it's the summary of the  
14 invention, the second or third sentence, it says first  
15 you hold it in a carrier, the phone or the device. Then  
16 it says a wire having a thickness of less or equal to  
17 that of the intermediate layer is coplanar would set into  
18 the intermediate layer. So the wire being a thickness of  
19 less than or equal to that of the intermediate layer is  
20 the key to having that coplanar relationship. Because  
21 once you expose the intermediate layer on all sides, if  
22 the wire is the same you can -- there's one available  
23 plane, and you can just push it into that one available  
24 plane. But if the wire is thinner -- and the  
25 specification explains that -- then there will be

1 multiple available planes in the intermediate layer that  
2 you could use to push the wire through. So that's what's  
3 explained here at Column 1, 53 to 59. But again, Column  
4 6, 4 through 9, by interposing a wire or a cutting blade  
5 of thickness equal to or less than that of layer 24. And  
6 as we saw in Figure 7, layer 24 is the intermediate  
7 layer. And the reason that's important again is because  
8 in order to align a wire with the planes of the  
9 intermediate layer it has to be the same size or less.  
10 If it's thicker, you can't do it.

11 And now with respect to coplanar relationship. As  
12 shown in Figure 5, and as will be explained herein, the  
13 use of a thin wire interposed between layers 22 and 26,  
14 which is the top layer and the bottom layer, and aligned  
15 in a coplanar relationship with the intermediate layer.  
16 So we have a thin wire. And thin really is the aspect of  
17 where they are taking the geometric definition and using  
18 it. Since the wire is so thin, technically as matter of  
19 geometry and we all agree the wire will have a --  
20 technically a top plane and a bottom plane. And we would  
21 agree that each of those technical geometry planes has to  
22 be lined up with the intermediate layer. But the  
23 specification uses the term and the claim uses coplanar  
24 relationship as if the wire was so thin it would be  
25 considered to have a one plane. And that's how it's

1 described. And this is describing it. It says  
2 preferably you align it as close as possible to the plane  
3 adjacent the electronic display portion which is away  
4 from the glass.

5 And then specification teaches again at 6, 10  
6 through 18, preferred method. You maintain the cutting  
7 element in a coplanar relationship with the plane  
8 adjacent the electronic display. This can be  
9 accomplished by aligning it carefully to maintain the  
10 coplanar relationship. So you're aligning it and you're  
11 pushing and you're trying to hold it aligned with that  
12 intermediate layer.

13 Then it goes on, it says the method can be  
14 practiced by aligning the wire in the same plane as the  
15 intermediate layer or in any plane between the two  
16 interface planes. The interface planes are the top and  
17 bottom layers. Now the defendants latch on to this and  
18 say, see the use of "or." It's saying it could either  
19 happen in the same plane, or between something different,  
20 any plane between the two. And they say this is  
21 confusing, one skilled in the art doesn't really know  
22 what this means. But the very next sentence explains it.  
23 Because the wire may be thinner than the layer, there  
24 could be multiple available planes. If they are  
25 approximately the same size then there's one available

1 plane, the wire is thinner, one skilled in the art would  
2 understand and you can put it in any plane.

3 And then Column 8, 65 to 67. Again, here it's  
4 saying it's preferably aligned with the intermediate  
5 layer at its midpoint or adjacent to the electronic  
6 display portion without engaging its surface. So it's  
7 saying there's multiple available planes to align it  
8 with. And that's why our construction has "a" and their  
9 construction has "the." In the same plane. And our  
10 construction has in a same plane. Because when you're in  
11 a coplanar relationship there could be more than one  
12 planes available and that's all we were trying to make  
13 clear there.

14 Now the defendants, the only evidence they rely on  
15 is The Facts on File Geometry Handbook. And this is what  
16 it says for the definition of coplanar; "lying on a  
17 common plane." And then on the right we have the claim  
18 line. And the question is would someone understand with  
19 reasonable certainty what it means to align a coplanar --  
20 align a cutting device in a relationship such that they  
21 are lying on a common plane such that it's lying on a  
22 common plane with the intermediate layer. And with  
23 reasonable certainty looking at Figure 7, we believe a  
24 person with skill in the art would know, and certainly  
25 know with a level of reasonable certainty what's meant

1       there.

2               Now in order to arrive at their argument regarding  
3       indefiniteness, defendants must disregard the claim  
4       context because the claim talks about your -- it's  
5       using -- it's not coplanar, it's coplanar relationship,  
6       and it's aligning the wire in the coplanar relationship  
7       with the intermediate layer which is fixed. To ignore  
8       the field of the invention, instead relying on geometry  
9       textbooks instead of anything from one of skill in the  
10      art. They misapply and misuse the specification and say  
11      one of skill in the art wouldn't understand what coplanar  
12      means in light of the specification. With the  
13      specification itself, at least in our view, provides an  
14      understanding with more than reasonable certainty what  
15      the phrase means.

16              The defendants also disregard the geometric  
17      phrases are often used in claims to describe real-world  
18      relationships between three-dimensional objects such as  
19      parallel and perpendicular. Defendants have no evidence  
20      from one of skill in the art, no opinion testimony. And  
21      the defendants also disregard the courts, both the fed,  
22      circuit, and district courts who routinely recognize that  
23      words like coplanar can be used to describe the  
24      relationship between real-world objects.

25              And lastly, in the Whirlpool case this Court

1 recognized that expert declaration to demonstrate the  
2 understanding of one of skill in the art is typically  
3 necessary for a finding of indefiniteness. And here, the  
4 defendant's argument is based almost solely on attorney  
5 argument, other than the geometry textbook which I  
6 referenced earlier.

7 And just one last thing before I sit down. I  
8 wanted to point out on the biasing step, away from the  
9 glass. In the parties' briefing -- and this is from the  
10 defendant's brief themselves -- we agreed that away from  
11 the glass means in the Z direction. So the force is not  
12 applied as you're pushing it into, that's not in the Z  
13 direction. This is recognized on page nine of the  
14 defendant's brief. They said, "the parties further agree  
15 that the claim biasing step requires that a force is  
16 applied to the cutting device in the direction along the  
17 Z axis." So there was some confusion based on the  
18 defendant's argument. They said, well, you're biasing as  
19 you're pushing in. That's not the claim biasing. The  
20 claim biasing goes down, and you can only do that claim  
21 biasing in the intermediate layer. And it goes away --  
22 away from the glass. That's the direction it goes if  
23 you're pushing down. Why? To get around those shards of  
24 glass, and that's what's described in the spec. And in  
25 the parties briefing they agreed to that, but defendant's



1 just argued that, no, you could be biasing as you're  
2 going in and that's why it requires construction and  
3 that's why it's confusing. The plain language of the  
4 claim states that the biasing must occur away from the  
5 glass. If this Court would like to clarify that to the  
6 extent the defendants intend to argue otherwise, we would  
7 not object to that. But away from the glass is certainly  
8 correctional.

9 That's all, Your Honor.

10 THE COURT: All right. Let me hear from the  
11 defendants.

12 MR. DEANE: So, Your Honor, as we know, the  
13 coplanar relationship term that's at issue here is part  
14 of this aligning step. And we believe here that  
15 plaintiff is correct that there's two principle disputes.  
16 And the defendant's construction of coplanar is the first  
17 dispute, and then whether the term is indefinite is the  
18 second dispute. I'm going to address the first part  
19 first here.

20 And what we believe is that the defendant's  
21 construction of in the same plane is the proper  
22 construction. Plaintiff's construction of in a same  
23 plane is inconsistent with basic geometry. And as you  
24 just heard them come up here and say, they actually now  
25 have even expanded it more to mean it just has to share

1 more than one plane. And we think that that's completely  
2 inconsistent with the definition of coplanar as Your  
3 Honor pointed out, we all learned in ninth or tenth grade  
4 geometry.

5 So certainly under all constructions the term is  
6 indefinite. But when you look at claims construction,  
7 their construction is now so broad that it absolutely is  
8 indefinite and we'll show you why here in a minute. I  
9 think it may help to start at a high level.

10 Up here on the screen is U.S. Patent -- or U.S.  
11 Application 2010/0199818 from the file history. And this  
12 is showing that in the art these generic cutting machines  
13 were known. As Your Honor alluded to earlier, this is  
14 the cheese slicer. You can manually have a wire pulled  
15 through reels. You can manually slide a block that's  
16 bonded together to separate the layers of that block, and  
17 it was used in various contexts. But these rudimentary  
18 machines are not what plaintiff claims to have invented.  
19 The machine on the right is from the asserted patents.  
20 And what the plaintiff claims to have invented is a  
21 machine that precisely aligns the wire -- you saw them  
22 pull up those specification passages that say that -- and  
23 then biases the wire in a specific way in the  
24 intermediate layer.

25 And we believe this is evident from the claims.

1 What's up here on the screen is Claim 1 from the 953  
2 Patent, and it says a display unit in blue -- and that's  
3 from Figure 7, shows the phone as the display unit --  
4 defining an axis extending along said intermediate layer.  
5 And that axis is the X or Y axis that's shown on the  
6 screen in Figure 7. These are where the cutting device  
7 must be aligned in the aligning step to be coplanar.

8 And we can see that this axis -- we can see that  
9 one of these axes is important because in the driving  
10 step you drive the cutting device into the intermediate  
11 layer relative to this display unit axis. So this  
12 geometry is important to the claim. The coplanar  
13 relationship is fundamental to the claim. And so the  
14 defendant is focused on what coplanar means. And again  
15 as Your Honor alluded to, coplanar means in the same  
16 plane. Points A, B, and C are coplanar. Lines A/B and  
17 C/D are coplanar. These are simple concepts that we all  
18 learned from ninth and tenth grade geometry. And this is  
19 a basic mathematical principle, Your Honor. You can take  
20 judicial notice of what coplanar means. You don't need  
21 expert testimony for somebody to come in here and tell  
22 you that.

23 We also know what coplanar doesn't mean. Point C  
24 is not coplanar with points A and B. Likewise, if we  
25 have parallel planes those are not coplanar. C and D and

1 A and B are not coplanar. And importantly here, Your  
2 Honor, intersecting planes are not coplanar. Points C  
3 and D and points A and B on these intersecting planes are  
4 not coplanar. And we don't think that any tenth grade  
5 geometry student would come up here and tell you  
6 otherwise. But plaintiff's definition of sharing a same  
7 plane, or as they alluded to up here, sharing one or more  
8 planes, is so broad that they are going to come in here  
9 and argue later that it captures these orientations.

10 So going back to the patent, Your Honor, here's  
11 Figure 3. And I've annotated it with the wire across the  
12 machine and the X/Y axis shown on top here. And if this  
13 claim is definite, Your Honor, then this is the only  
14 possible thing that coplanar can mean. In the same plane  
15 as the X and Y axis that defines the intermediate layer.  
16 It's kept taut --

17 THE COURT: What about the situation, Mr. Deane,  
18 where opposing counsel argued that given a disparity  
19 between the width of the wire and the width of the  
20 intermediate area that there could be multiple planes all  
21 parallel to each other, but within the larger  
22 intermediate area than the single width of the wire? Are  
23 those all the same plane in your mind because they are  
24 parallel to each other?

25 MR. DEANE: No. We disagree with that, Your

1 Honor. It's shown on this slide, points in two parallel  
2 planes are in fact by definition not coplanar. And  
3 that's the problem with plaintiff's claim, is they've  
4 used three-dimensional language in a two-dimensional way  
5 and they've meshed them together in a way that  
6 is uncertain and subjective to somebody trying to read  
7 the claims.

8 And so in the aligning step -- which again, Your  
9 Honor, is a precise alignment that the plaintiffs here  
10 have invented. What they've done is not define any  
11 reference point on the wire or any reference point in the  
12 intermediate layer that is supposed to be coplanar with  
13 each other. Instead, they've just simply said put these  
14 two objects together and therefore they must be coplanar.  
15 And we think fundamentally what that is, is leaving the  
16 word coplanar out of the claim. What plaintiff's want  
17 you to do is say that if you would align in any  
18 relationship with the intermediate layer then you have  
19 met the claim definition of aligning in a coplanar  
20 relationship. And we think that's exactly why a person  
21 of skill in the art, or anybody knowing what the  
22 definition of coplanar means, would know that without a  
23 reference point you can't actually align precisely in  
24 what layer of the intermediate layer the wire needs to be  
25 aligned. I'm sorry, you don't know what layer in the

1 intermediate layer this wire is supposed to be aligned  
2 in.

3 THE COURT: But aren't you asking me to take a  
4 two-dimensional concept that relates to a three-  
5 dimensional process and say the square peg won't fit in  
6 the round hole, and therefore we win? Because this is a  
7 two-dimensional process, it can't be applied in the  
8 three-dimensional context even if we have language like  
9 coplanar relationship, as opposed to absolutely coplanar.

10 MR. DEANE: No, Your Honor, I do not believe that  
11 we're asking you to do this. What the plaintiff is  
12 asking you to do is to rewrite the claim to avoid that  
13 exact problem. What the plaintiff could have done is the  
14 plaintiff could have provided you a reference point. For  
15 example, the plane that runs on the top of the wire.  
16 They alluded that the wire has an upper boundary plane  
17 and a lower boundary plane. They could have said that  
18 plane is coplanar with the plane defined by the plane  
19 adjacent to the electronic display. Those would be in a  
20 coplanar relationship. Likewise, they could have said a  
21 midpoint of a wire is coplanar with a midpoint of a  
22 intermediate layer, but they didn't do that. Instead  
23 through their claim drafting and their choice of the  
24 words, they have made this claim virtually impossible to  
25 figure out where this wire is supposed to be aligned.

1 And that exact subjectivity is what gives rise to the  
2 indefiniteness problem, certainly, you know, under  
3 defendant's definition, but most certainly now under  
4 plaintiff's definition. And that's where we -- you know,  
5 we don't think that plaintiff's definition solves this  
6 problem of two dimensional versus three dimensional.

7 And if I can show why -- you know, I have this  
8 illustration that I think expands what we're talking  
9 about here where I have taken Figure 7, rotated it, and  
10 then just sort of blown it up so that the intermediate  
11 layer is shown here. And, you know, we think that if  
12 Your Honor is going to find this term definite, this is  
13 what it is. It's a straight parallel wire in a parallel  
14 plane with the X/Y axis that we were just talking about  
15 in the claim, and that's the only thing it can possibly  
16 be. But the problem with plaintiff's definition -- and  
17 if you look at what plaintiff says is they said we're not  
18 even applying that geometric definition to these terms.  
19 We're not applying what a -- how a professor would use  
20 this term. And they say that -- you know, they've  
21 defined a -- somebody with a background in engineering,  
22 but a person with a background in engineering would apply  
23 this term in the same way that they learned it in ninth  
24 or tenth grade. What they are saying is that the  
25 asserted patents have a special definition. But they

1 haven't given this special definition, they've simply  
2 changed the word "the" to the word "a". From a legal  
3 perspective, that now changes entirely what the term  
4 means, and it removes it completely from what everybody  
5 that took tenth grade geometry would understand.

6 And here's an example of this, Your Honor. This  
7 is now a slanted wire that's going through the  
8 intermediate layer. It's no longer parallel to that  
9 critical X/Y axis. It's no longer sitting in any  
10 parallel plane. But the language that the plaintiff came  
11 up here and used was that the wire simply has to share  
12 more than one plane with the intermediate layer. Well,  
13 now they are going to come up here and try to argue that  
14 this maybe falls within their construction of the term.  
15 And we think likewise, this one too shares more than one  
16 plane with the intermediate layer. This would be a  
17 vertical wire going through. And this one, Your Honor,  
18 this is a wire that's bent as it's going through the  
19 intermediate layer. It's not even coplanar with itself,  
20 but as we saw, it has intersecting planes and those  
21 planes could share more than one plane with the  
22 intermediate layer. And we think that by departing from  
23 the geometric definition of this term they've now  
24 rendered their claim even more indefinite. Now a person  
25 of ordinary skill in the art that was stuck trying to



1 figure out where to align the wire in a parallel  
2 relationship with the upper and lower bounds of the  
3 intermediate layer, are now stuck trying to figure out  
4 how to actually orient the wire in the intermediate  
5 layer. And that from our perspective, Your Honor, you  
6 know, renders the claim indefinite because it provides no  
7 reasonable certainty to anyone trying to accomplish the  
8 aligning step using this coplanar relationship. And  
9 that's a function of how the plaintiff drafted their  
10 claim term. They didn't have to draft it that way. They  
11 didn't have to ask Your Honor to rewrite it. They could  
12 have done it right the first time. But instead, what  
13 they need you to do now is they need you to come in and  
14 essentially write out the word coplanar to save the  
15 definiteness of their terms and we think that that's  
16 improper under the legal standard. We don't think that  
17 aligning a cutting device in any relationship with the  
18 intermediate layer is the proper way to construe this  
19 term to save it from being indefinite.

20 And I'll address the cases that were cited for the  
21 first time in plaintiff's reply brief. And the only case  
22 that they cited which actually tried to construe the term  
23 coplanar, that was the Graco Childrens Product case.  
24 They construed the term coplanar exactly as the  
25 defendants ask you to construe it here. They interpreted

1 it as in the same plane. Didn't say in a same plane  
2 because while those geometric handbooks may have said in  
3 a plane, in the legal sense a plane means one or more  
4 planes. And that's exactly what they came up here and  
5 asked you to do, was rewrite their claim so that it means  
6 something that it doesn't mean. And that's precisely why  
7 the Court here said in the same plane. Likewise, the  
8 federal circuit here, they had no trouble using the word  
9 coplanar not to -- not in a construction, not in the  
10 context of indefiniteness, but to describe a flat panel  
11 36. Here they are using 2D language, flat panel, and  
12 they are saying that the flange 40 that was bent out of  
13 the plane of the flat panel was not coplanar with the  
14 otherwise flat panel. That's completely consistent with  
15 how defendants are using the term. And we don't think  
16 that there's any inconsistency there with using two-  
17 dimensional language and using the term coplanar in that  
18 context.

19 In the other case that they cite here was a case  
20 against Trinity Industries, and this was a guardrail  
21 head. And the Court here -- again not construing the  
22 term coplanar -- said Edge 70C is in a coplanar  
23 relationship with Edge 72D. There's no inconsistency  
24 here. The Court there was using two-dimensional language  
25 and said in that context that those two things were

1 coplanar. And so again, it's not that you can never use  
2 a term like parallel, or perpendicular, or coplanar, it's  
3 that you have to set your claim up so that a person of  
4 ordinary skill in the art would understand what reference  
5 points you're using to then define those dimensions. And  
6 we think that fundamentally is the problem with the way  
7 that they wrote their claim and why this particular claim  
8 is indefinite.

9 THE COURT: Let me ask you this, Mr. Deane, and  
10 let's focus on coplanar, not coplanar relationship, where  
11 we have plaintiff's proposed "in a same plane" and your  
12 proposed "in the same plane."

13 I agree with you that -- and I don't know where on  
14 your slide that the picture is, but back where you had  
15 the bent wire and the different angles of the wire going  
16 through the intermediate layer.

17 Yeah, back it up before that. There you go.  
18 Leave it on that one.

19 I understand that that's objectionable and  
20 probably not intended, and I accept that as a fairly  
21 valid argument. Here's the problem. As long as that  
22 wire has a smaller size than that intermediate layer,  
23 then there are multiple parallel planes within the  
24 intermediate layer where that wire could pass through and  
25 be not at an angle, but be at a same parallel plane with

1 the bottom of the glass or the top of the electronic  
2 display. And so you're telling me that their definition  
3 opens the door to this, they are telling me that your  
4 definition precludes any plane that's parallel to the  
5 bottom of the glass or the top of the electronic display  
6 because there are multiple planes and you say it must be  
7 the same plane. So how do you -- how do you suggest to  
8 the Court that I rectify that? Because I think their  
9 point is valid, that if the wire is smaller than the size  
10 of the intermediate layer then whether it comes in a  
11 third of the way down the intermediate layer from the  
12 top, or halfway down, or a third from the bottom, it's  
13 coming in at a parallel coplanar direction. And I don't  
14 think there's a problem with that. I think there is a  
15 problem with what you're afraid of here. So between "a  
16 same plane" and "the same plane," how do you suggest that  
17 I preclude them from being handcuffed by what they are  
18 afraid of, and also protect you from being handcuffed  
19 from what you're afraid of?

20 MR. DEANE: Well, I think, Your Honor, if you  
21 adopted our definition of in the same plane you could  
22 still find the term indefinite -- or I'm sorry, find the  
23 term definite. I think that our definition --

24 THE COURT: Well, you haven't argued coplanar is  
25 indefinite. You've argued aligning in a coplanar

1 relationship is indefinite. But your indefinite argument  
2 doesn't apply to the term coplanar by itself. Not as I  
3 read the briefing.

4 MR. DEANE: That's correct, Your Honor. And I  
5 guess -- I guess our -- our point would be that if you're  
6 going to find the term definite that -- that you are  
7 correct that this is the way that it's supposed to be.  
8 It's supposed to be this parallel or this straight, taut  
9 wire aligned in the plane in the intermediate layer that  
10 is consistent with that X/Y axis.

11 THE COURT: So if the length of that intermediate  
12 layer is 150 miles, the wire doesn't move up or down, it  
13 rides through that intermediate layer at the same  
14 relationship to the glass and the electronic device if it  
15 is in fact coplanar.

16 MR. DEANE: I think setting aside the biasing step  
17 and sort of what you heard with the argument about the Z  
18 axis, you're focusing on the aligning step.

19 THE COURT: Right.

20 MR. DEANE: Yes. The plane that is 150 miles wide  
21 and infinite in all directions here would be in the same  
22 plane as the intermediate layer. And in this particular  
23 example, adjacent to the electronic display consistent  
24 with the X/Y axis.

25 THE COURT: And do you agree that in this drawing

1 with the intermediate layer certainly larger than the  
2 size of the wire -- and again, I'm talking about the  
3 distance from the top of the intermediate layer to the  
4 bottom of the intermediate layer versus the top edge of  
5 the wire to the bottom edge of the wire, assuming there's  
6 a clear disparity between those two things such that the  
7 height or the distance from top to bottom of the  
8 intermediate layer is considerably larger than the same  
9 dimension of the wire, that as long as it enters that  
10 intermediate layer in a coplanar fashion -- or let me say  
11 it another way. As long as it is aligned to enter that  
12 intermediate layer in a coplanar parallel fashion, that  
13 that is not what you're complaining about and defendants  
14 are all right with that, then that's one thing. But if  
15 you're telling me when we get down the road and you're  
16 going to say because it doesn't specify the same plane,  
17 it doesn't specify where on the height of that  
18 intermediate layer it's going to come in, therefore it's  
19 not properly aligned, therefore we win, game over, that's  
20 something I need to know about now. Because it sounds  
21 like to me your point that it can't be at an angle or  
22 something other than parallel with the plane is correct,  
23 but that's not the same thing as saying it can only enter  
24 the intermediate layer at this one point and it's  
25 precluded from entering or being aligned to enter the

1 intermediate layer at any parallel plane within the  
2 distance between the top of the intermediate layer and  
3 the bottom of the intermediate layer. Is that clear?

4 MR. DEANE: Understood, Your Honor. And, yes, and  
5 I can address that.

6 So as part of our indefiniteness argument here at  
7 Markman, that is our argument. Our argument is that  
8 because we don't know where it's supposed to be aligned,  
9 whether at the top, the midpoint, or the bottom, based  
10 off the words coplanar relationship, and because of  
11 plaintiff's choice to use two, three-dimensional objects  
12 and say they should be aligned in a coplanar  
13 relationship, that that is precisely what renders the  
14 term indefinite.

15 Now if Your Honor decides that we are incorrect  
16 and that that -- the term is not indefinite, then we  
17 believe that our construction is this -- in the same  
18 plane is this parallel construction that you see on the  
19 screen, where again if -- if we're operating under Your  
20 Honor's ruling that the term is definite and that a  
21 person of ordinary skill in the art would know with  
22 reasonable certainty what plane it's supposed to be  
23 aligned in, then we would come in and say that the  
24 parallel to those parallel planes like a deck of cards  
25 almost, any one of those planes as long as the wire is

1 parallel would mean in the same plane relationship.

2 THE COURT: Okay. You've answered my question.

3 What else do you have for me on this?

4 MR. DEANE: Nothing else, Your Honor.

5 THE COURT: All right. Then I've heard argument  
6 on all the terms. I'm happy to hear further argument but  
7 I don't really think it's necessary unless somebody feels  
8 there's something very pressing that we've overlooked  
9 somehow.

10 Plaintiff's counsel, you look like you want to  
11 stand up and say something. Are you satisfied with the  
12 argument or do you think there's something that has been  
13 overlooked?

14 MR. PETRSORIC: I was just going to add one thing,  
15 Your Honor. We're okay with the parallel. We used "a  
16 plane" because it's both the top plane and the bottom  
17 plane of the wire and the coplanar relationship. So just  
18 to make clear, we weren't trying to argue, you know, the  
19 sideways and I think that's an easy way to solve the  
20 problem on that. It's the top plane and the bottom  
21 plane.

22 THE COURT: All right. Thank you.

23 All right. Then I'll consider that I've heard  
24 adequate and competing argument on the disputed terms for  
25 claim construction.



1                   And with that, Counsel, I want to transition. I  
2 will do my best -- these matters are under submission.  
3 I'll do my best to get you a claim construction opinion  
4 as soon as possible. But these disputes are under  
5 submission.

6                   I want to transition to what I had also noticed  
7 you for today, which is a status conference on pending  
8 motion, and motions to transfer or dismiss. And quite  
9 honestly, I did this because the Court was confused about  
10 the briefing and the argument. And I now think perhaps  
11 there's been some -- perhaps unintentionally, but there's  
12 been some light directed towards this problem that  
13 perhaps explains how we got to where we got to.

14                  Part of why I asked you, Mr. Pinker, about case  
15 357 and Assurant is after the cases were consolidated you  
16 amended your complaint to add Assurant but you filed it  
17 in the lead case. You didn't file it in the 359 case.  
18 And the clerk's office has added Assurant to the 357 case  
19 and does not have Assurant in the 359 case. Now maybe  
20 that wasn't your intention, but the post consolidation  
21 amendment to add Assurant seems to have put it in a case  
22 that's not necessarily where you intended it to go. And  
23 consequently, in reading the briefing on the transfer  
24 issues, it looked like to me you were arguing I should  
25 take a part of the case and send it to Sherman and keep

1 the rest of the case in Marshall. And if you've got some  
2 additional clarification on this, let me know.

3 But what we've got is we've got the three cases  
4 that are consolidated. We've got a Motion to Transfer  
5 which seems to say I will conditionally concede propriety  
6 of venue if you transfer on a convenience basis, but  
7 that's only as to some defendants. We have other  
8 defendants who haven't moved. We have defendants who  
9 haven't taken a position. We have an allegation of  
10 convenience analysis that should take place, and we don't  
11 have convenience facts as to some defendants. Quite  
12 honestly, I'm not sure how is best to proceed with this  
13 venue issue that's been raised. And perhaps some of it  
14 is derived from the fact that your amendment may have  
15 unintentionally placed this added defendant in the wrong  
16 case because of the consolidation. I don't know. But I  
17 wanted to have a discussion of exactly what you're asking  
18 for and why you're asking for it so I have a better idea  
19 how to understand and approach the motions that are  
20 pending. Can you address these comments and add  
21 anything?

22 MR. PINKER: May I approach?

23 THE COURT: Please.

24 MR. PINKER: I will obviously try, Your Honor, and  
25 I apologize for the confusion. The complaint was

1 obviously amended by the plaintiff.

2 THE COURT: Right.

3 MR. PINKER: And that complaint as I understood it  
4 added I believe one defendant to the 359 case and removed  
5 the Reconext defendant from the 359 case. I filed a  
6 Motion to Transfer, and in the alternative Motion to  
7 Dismiss solely in connection with the 359 case. We  
8 filed it with the consolidated heading required by the  
9 Court's order to file everything in a consolidated  
10 fashion. And if that resulted in confusion, I very much  
11 apologize for that.

12 THE COURT: Well, you're exactly right. It's the  
13 plaintiffs that amended the complaint, I didn't mean to  
14 indicate otherwise. But somehow, some way, the clerk's  
15 office at least from my reading of the docket is now  
16 showing the defendant Assurant in the 357 case and not in  
17 the 359 case.

18 MR. PINKER: The defendant Assurant is in the 357  
19 case, Your Honor. I represent in the 359 case the  
20 following six defendants who are all of the defendants in  
21 the 359 case. Defendants Clover Technology Group, Clover  
22 Wireless, Valu Tech Outsourcing, Teleplan Holdings,  
23 Teleplan Services, and Teleplan Services of Texas. Those  
24 six defendants are to my understanding, the six  
25 defendants named in the First Amended Complaint of the

1 359 case.

2 THE COURT: Well, and I've discussed Assurant and  
3 perhaps I named the wrong defendant. Valu Tech is  
4 being -- Valu Tech, Teleplan is listed as a defendant in  
5 the 357 case, not in the 359 case. And the First Amended  
6 Complaint for Patent Infringement Document Number 24  
7 filed in the 357 case shows as the heading of -- or the  
8 style of that amendment Viking Technologies vs. Clover  
9 Technologies, Clover Wireless, Outsourcing, Teleplan  
10 Holding, Teleplan Service Logistics, and Teleplan  
11 Services Texas, Inc. Valu Tech is not shown in the style  
12 of the First Amended Complaint regarding the 359 case,  
13 and this First Amended Complaint is filed in the lead  
14 case, the 357 case.

15 Maybe plaintiff can add some clarification to  
16 this. And while you're going to the podium, why don't  
17 you explain to me at a little bit of a higher level why  
18 in light of Section 299 of the AIA, we've got multiple  
19 defendants in a patent infringement case when each one  
20 has got a right to a separate jury trial? Did you expect  
21 me to sever all of these sua sponte, or why are they all  
22 lumped into one case?

23 MR. DEVINCENZO: They are all related. The 357,  
24 358 and 359 were all filed in related because each of  
25 those cases involves related entities, and we understood

1       that there were acts of infringement that would have cut  
2       across multiple corporate entities within the families.

3               THE COURT: Well, when you amended in Document 24,  
4       what was your intention with regard to Valu Tech? Was it  
5       to go into the 357 case which is the case number listed  
6       on your amended complaint, or was it to go into the 359  
7       case? And if it was to go into the case with Clover, et  
8       cetera, which is the 359 case, and why was it named in  
9       the style of the amendment so that that would be clear?  
10      That's where the confusion is coming from.

11              MR. DEVINCENZO: I understand, Your Honor, and  
12      without full clarification I would assume that that's at  
13      least at the very least a clerical error on our part and  
14      we likely filed the amended complaint for the -- what  
15      I'll call the Clover entities which includes Valu Tech  
16      and who were originally named in the 359 case, the  
17      amended complaint was likely filed in the 357 case,  
18      thereby creating this confusion.

19              So what I would believe, that we would be able to  
20      clean this up and make sure we style each of the cases  
21      correctly as separated.

22              THE COURT: Okay. So from what I'm hearing, Valu  
23      Tech should be in the 359 case and not in the 357 case.

24              And let me ask you this, Mr. Pinker. In light of  
25      that, is your motion regarding venue only limited to the

1 359 case or do you purport that it should apply to either  
2 the 357 or 358 case?

3 MR. PINKER: It is only limited to the 359 case,  
4 Your Honor.

5 THE COURT: Okay.

6 MR. DEVINCENZO: Was there a question pending for  
7 me, Your Honor?

8 THE COURT: Well, clearly there was some confusion  
9 as to the state of the docket and what the briefing on  
10 the motion was apparently trying to ask for and I  
11 couldn't reconcile in my mind how the briefing was asking  
12 for that relief if the alignment of the parties on the  
13 docket was correct. And so that's really what prompted  
14 this status conference being noticed today.

15 MR. DEVINCENZO: Understood. And so we will make  
16 sure we clean up any of the clerical snafus then with  
17 respect to the alignment of the parties within the -- at  
18 least within 359 versus the 357, and we'll doublecheck if  
19 there's any other issues there as well.

20 THE COURT: Well, it sounds like from this  
21 exchange that both plaintiff and defendants are all on  
22 the same page, that this may be misaligned through an  
23 unintentional clerical error more than anything else.

24 MR. DEVINCENZO: Yes, Your Honor. And I apologize  
25 to the Court for that.

1 THE COURT: Okay. So plaintiff intends Valu Tech  
2 to be in the 359 case represented by Mr. Pinker's firm,  
3 and not the 357 case. And that's Mr. Pinker's  
4 understanding as well, that his firm represents all of  
5 the defendants in the 359 case but none of the other  
6 parties, correct?

7 MR. DEVINCENZO: That is correct, Your Honor.

8 MR. PINKER: That is correct from our perspective  
9 as well, Your Honor.

10 THE COURT: Okay. Then I think in light of that  
11 clarification I can go back to what's pending, but I  
12 would suggest that action be taken to make sure the  
13 docket reflects what the parties have just indicated they  
14 believe the alignment of the parties should be.

15 MR. DEVINCENZO: We will make sure it's amended,  
16 Your Honor.

17 THE COURT: Okay. Thank you. That helps. That's  
18 really all the clarification I needed. I think I can now  
19 go back to what's pending, in light of that clarification  
20 and go forward with my analysis.

21 All right. Is there anything else related to  
22 either the status conference issue or related to the  
23 claim construction disputes that I've heard argument on  
24 that either party believes hasn't been somehow addressed  
25 or raised and needs to be raised with the Court at this

1 time?

2 MR. EVERINGHAM: Nothing from the plaintiff, Your  
3 Honor.

4 MR. DEANE: Nothing from us, Your Honor, as well.

5 THE COURT: Okay. Well, as I say, these claim  
6 construction disputes are under advisement. I'll do my  
7 best to get you some written guidance by way of claim  
8 construction opinion as soon as practical. And I thank  
9 you for your attendance and argument.

10 The Court stands in recess, the parties are  
11 excused.

12 (End of proceedings)



1 I certify that the foregoing is a correct transcript from the  
2 record of proceedings in the above-entitled matter.

3  
4 /s/ Lori Barnett  
COURT REPORTER

8/2/21  
DATE